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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,402	11/28/2001	Samir Narendra Mehta	320037.402	2381

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MOTOROLA INC
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LIBERTYVILLE, IL 60048-5343

EXAMINER

DOAN, DUYN MY

ART UNIT	PAPER NUMBER
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2152

NOTIFICATION DATE	DELIVERY MODE
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01/18/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

09/997,402

Applicant(s)

MEHTA ET AL.

Examiner

Duyen M. Doan

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33,35,36,39-51,55,56,58 and 60-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33,35,36,39-51,55,56,58 and 60-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/1/2007.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to the submission filed on 11/1/2007. Claims 1-33,35,36,39-51,55,56,58 and 60-73. Claims 34,37-38,52-54,57,59 are cancelled.

Response to Arguments

Applicant's arguments with respect to claims 1-33,35,36,39-51,55,56,58 and 60-73 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the device". There is insufficient antecedent basis for this limitation in the claim. For the purpose of examination, examiner assumes that applicant means "the target wireless device" instead of the device.

The dependent claims are depended on the rejected independent claim, therefore rejected for the same rationale.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claimed invention is directed to non-statutory subject matter.

Claims 30-33,35-36,39-44, 61-73 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 30, 61 currently recite computer software components for manipulating data. As currently recited, the invention is functional descriptive material because it comprises merely software for manipulating data.

Data structure not claimed as embodied in computer-readable media are descriptive material *per se* and are not statutory because they are not capable of causing functional change in the computer. See, e.g., *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760. Such claimed data structure do not define any structural and functional interrelationship between the data structure and other claimed aspects of the invention which permit the data structure's functionality to be realized.

In contrast, a claimed computer-readable medium encoded with a data structure defines structural and functional interrelationship between the data structure and the

computer software and hardware components which permit the data structure's functionality to be realized, and is thus statutory.

The dependent claims are depended on the rejected independent claim, therefore rejected for the same rationale.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-33,35-36,39-51,55-56,58,60-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tso et al (Us pat 6,088,803) (hereinafter Tso) in view of Subramaniam et al (us pat 6,640,302) (hereinafter Sub), and further in view of Jamtgaard et al (us pat 6,430,324) (hereinafter Jam).

As regarding claim 1, Tso discloses determining whether pre-provisioned content corresponding to the target device exists (see Tso col.8, lines 2-25, determine if the object is found or not found in the cache) where the pre-provisioned content exists, determining whether the pre-provisioned content is stored locally or with a trusted third party host (see Tso col.6, lines 41-55, the content is store at the server-side cache), and where the pre-provisioned content is unavailable, selecting content from

remotely stored, untrusted applications and provisioning the content for the target device (see Tso col.7, lines 33-63; col.8, lines 2-25, if the content is not existed in the cache memory, request the content from the network), wherein the provisioning comprises intercepting the content and inspecting the content, wherein the inspecting comprises at least one of examining the content to detect malicious code, determining whether the content contains banned code, and determining whether the content contains designated API (see Tso col.2, lines 37-67; col.3, lines 2-10, lines 55-67; col.5, lines 27-43, virus scanning process).

Tso does not disclose the pre-provisioned content is stored with the trusted third party host, retrieving the pre-provisioned content from the trusted third party host, and providing the pre-provisioned content to the target wireless device; verifying that the device supports execution of the content by comparing the device capabilities to the content requirements; and providing the verified and provisioned content to the target wireless device.

Sub teaches pre-provisioned content is stored with the trusted third party host, retrieving the pre-provision content from the trusted third party host and providing the pre-provisioned content to the target wireless device (see Sub col.10, lines 50-60, the border server carries the secure data from the target server to external client, the target server only holds the secure data, also see col.5, lines 64-67, the target client is the wireless device).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Sub to the method of Tso to include the

content is store at the trusted third party host and provide the content to the wireless target device for the purpose of provide a user outside the secure network with convenient, efficient, and secure access to data stored on server located within the secure network (see Sub col.3, lines 7-12).

The combination of Tso-Sub does not teach verifying that the device supports execution of the content by comparing the device capabilities to the content requirements; and providing the verified and provisioned content to the target wireless device.

Jam teaches verifying that the device supports execution of the content by comparing the device capabilities to the content requirements and providing the verified and provisioned content to the target wireless device (see Jam col.4, lines 1-20, deliver the content to the devices with different display format, it is inherently that when delivering the content to devices with different capabilities, the server has to compare the device capability to the content, otherwise, what's the purpose of delivering the content to the device if the device cannot support the delivered content).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to combine the teaching of Jam to the method of Tso-Sub to include compare the device capabilities to the content requirements for the purpose of providing content to the target device intelligently wherein the content delivered in a customized manner to the different information appliances (see Jam col.2, lines 22-25).

As regarding claim 2, Tso-Sub-Jam discloses causing the prepared content to download to the target device over a wireless transmission medium (see Sub col.6, lines 1-5). The same motivation was utilized in claim 1 applied equally well to claim 2.

As regarding claim 3, Tso-Sub-Jam discloses the content is requested by a subscriber of a carrier to the computer-based environment over a wireless transmission medium (see Sub col.6, lines 1-5). The same motivation was utilized in claim 1 applied equally well to claim 3.

As regarding claim 4, Tso-Sub-Jam discloses the provisioning comprises at least one of: inspecting the content; optimizing the content; and instrumenting the content (see Tso col.2, lines 37-53).

As regarding claim 5, Tso-Sub-Jam discloses wherein the provisioning comprises inspecting the content, wherein inspecting the content comprises an operation selected from the group consisting of deconstructing a structure of the content, checking for malicious code, checking for banned code (see Tso col.2, lines 16-67; col.3, lines 1-10, lines 30-38; lines 46-54, lines 62-67; col.5, lines 44-67; col.6, lines 1-24, lines 38-60, check the content from the remote content providers to determine if there are viruses before give it to client), determining the applicable application of filters, and checking a number of activated threads (see Tso col.2, lines 16-67; col.3, lines 1-10, lines 30-38; lines 46-54, lines 62-67; col.5, lines 44-67; col.6, lines 1-24, lines 38-60).

As regarding claim 6, Tso-Sub-Jam discloses wherein the inspecting further comprises determining whether the application contains designated API wherein the API is at least one of packages, classes, methods, and fields (see Jam col.4, lines 8-20). The same motivation was utilized in claim 1 applied equally well to claim 6.

As regarding claim 7, Tso-Sub-Jam discloses wherein the determining the applicable application of filters comprises retrieving an application filter relevant for potential target under examination, API suspected to have intrusive behavior, API suspected to have malicious behavior and API that are unauthorized for use (see Tso col.2, lines 16-67; col.3, lines 1-10, lines 30-38; lines 46-54, lines 62-67; col.5, lines 44-67; col.6, lines 1-24, lines 38-60; also see Sub col.11, lines 9-43).

As regarding claim 8, Tso-Sub-Jam discloses wherein the provisioning comprises inspecting the content, wherein the inspecting is performed using an application filter, wherein the application filter specifies a list of criteria to be filtered and a target (see Sub col.4, lines 34-57). The same motivation was utilized in claim 1 applied equally well to claim 8.

As regarding claim 9, Tso-Sub-Jam discloses wherein the criteria is an API (see Tso col.6, lines 55-60).

As regarding claim 10, Tso-Sub-Jam discloses wherein that target is at least one of a specified client, device type, content identifier, and global definition (see Sub col.6, lines 32-52 target device). The same motivation was utilized in claim 1 applied equally well to claim 10.

As regarding claim 11, Tso-Sub-Jam discloses wherein the provisioning comprises optimizing the content, wherein the optimizing comprises at least one of: reducing the size of variable names; modifying instructions to more efficient instructions; mapping executable paths in code, and removing unused code (see Tso col.6, lines 3-24, remove of predetermined content).

As regarding claim 12, Tso-Sub-Jam discloses wherein the provisioning comprises instrumenting the content, wherein the instrumenting comprises inserting code that implement at least one of a billing policy, a usage policy, a notification, and an automatic content update mechanism (see Sub col.10, lines 50-60). The same motivation was utilized in claim 1 applied equally well to claim 12.

As regarding claim 13, Tso-Sub-Jam discloses wherein the verifying that the device supports execution of the content further comprises identifying a device, accessing capabilities of the device form a device profile, accessing device requirement of the content, and determining whether resources required by the content are available

according to the device profile (see Jam col.4, lines 1-49). The same motivation was utilized in claim 1 applied equally well to claim 13.

As regarding claim 14, Tso-Sub-Jam discloses wherein the device profile contains information relevant to the capabilities of the device, wherein the information relevant to the capabilities of the device are selected from the group consisting of memory capacity, processor type, processing speed, and maximum size of a downloadable application (see Jam col.4, lines 1-49). The same motivation was utilized in claim 1 applied equally well to claim 14.

As regarding claim 15, Tso-Sub-Jam discloses wherein the billing policy comprises at least one of subscription based billing; trial use, download based billing, transmission based billing, and prepaid billing (see Sub col.10, lines 50-60). The same motivation was utilized in claim 1 applied equally well to claim 15.

As regarding claim 16, Tso-Sub-Jam discloses wherein the billing policy is provided by a wireless carrier infrastructure (see Sub col.6, lines 2-15). The same motivation was utilized in claim 1 applied equally well to claim 16.

As regarding claim 17, Tso-Sub-Jam discloses wherein the content is provisioned for a requester, and the verifying further comprising at least one of: comparing the API used by the content to the API supported by the target device and

determining whether the requestor is authorized to use the content (see Jam col.4, lines 1-49). The same motivation was utilized in claim 1 applied equally well to claim 17.

As regarding claim 18, Tso-Sub-Jam discloses wherein determining whether the requestor is authorized determines whether the requester has sufficient funds in a prepaid billing account to use the content (see Sub col.6, lines 2-15). The same motivation was utilized in claim 1 applied equally well to claim 18.

As regarding claim 19, Tso-Sub-Jam discloses wherein the verification is accomplished using profile management (see Jam col.8, lines 26-46). The same motivation was utilized in claim 1 applied equally well to claim 19.

As regarding claim 20, Tso-Sub-Jam discloses wherein the profile management defines profiles for at least one of a subscriber, device type, and content (see Jam col.8, lines 26-46). The same motivation was utilized in claim 1 applied equally well to claim 20.

As regarding claim 21, Tso-Sub-Jam discloses the content is java-based (see Jam col.4, line 20). The same motivation was utilized in claim 1 applied equally well to claim 21.

As regarding claim 22, Tso-Sub-Jam discloses wherein the environment is integrated with a wireless carrier infrastructure (see Sub col.6, lines 1-4). The same motivation was utilized in claim 1 applied equally well to claim 22.

As regarding claim 23, Tso-Sub-Jam discloses wherein the content preparation provides walled-garden provisioning (see Tso col.2, lines 16-67; col.3, lines 1-10, lines 30-38; lines 46-54, lines 62-67; col.5, lines 44-67; col.6, lines 1-24, lines 38-60; also see Sub col.11, lines 9-43). The same motivation was utilized in claim 1 applied equally well to claim 23.

As regarding claim 24, Tso-Sub-Jam discloses the computer-based environment including a network, wherein the provisioning supports the designation of the content to be prepared through browsing to a location on the network (see Jam col.8, lines 26-46). The same motivation was utilized in claim 1 applied equally well to claim 24.

As regarding claim 25, Tso-Sub-Jam discloses wherein the network is the Internet (see Tso col.2, lines 23).

As regarding claim 26, Tso-Sub-Jam discloses wherein the preparation process takes into account preferences of a requestor of the content (see Jam col.8, lines 26-46). The same motivation was utilized in claim 1 applied equally well to claim 26.

As regarding claim 27, Tso-Sub-Jam discloses wherein attributes that control the provisioning are specified through website administration (see Jam col.5, lines 7-53).

The same motivation was utilized in claim 1 applied equally well to claim 27.

As regarding claim 28, Tso-Sub-Jam discloses wherein the provisioning comprises preparing an initial list of available applications (see Jam col.5, lines 7-53).

The same motivation was utilized in claim 1 applied equally well to claim 28.

As regarding claim 29, Tso-Sub-Jam discloses wherein the content contains at least one of text, graphics, audio, and video (see Jam col.5, lines 7-53). The same motivation was utilized in claim 1 applied equally well to claim 29.

As regarding claims 30-33,35-36,39-44 the limitations are similar to claims 1-29, therefore rejected for the same rationales as claims 1-29.

As regarding claims 45-51,55-56,58,60, the limitations are similar to claims 1-29, therefore rejected for the same rationales as claims 1-29.

As regarding claims 61-73 the limitations are similar to claims 1-20, 22-29, therefore rejected for the same rationales as claims 1-20, 22-29.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

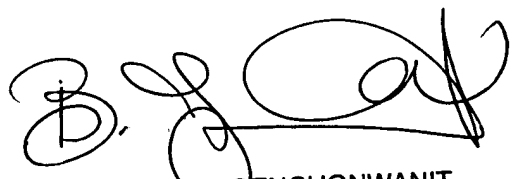
In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Duyen M. Doan whose telephone number is (571) 272-4226. The examiner can normally be reached on 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Examiner
Duyen Doan
Art unit 2152
1/14/2008


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1/15/08